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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
HIDEAKI YAMANAKA, ET AL. : EXAMINER: SHRESTHA, B.
SERIAL NO: 09/729,866 :
FILED: DECEMBER 6, 2000 : GROUP ART UNIT: 3691
FOR: DIGITAL CONTENT BILLING :
SYSTEM USING NETWORKS

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants appeal the Rejection of March 18, 2008.

I. REAL PARTY IN INTEREST

The real party in interest in the present application is the assignee of the present application, Mitsubishi Denki Kabushiki Kaisha, having a place of business at 2-3 Marunouchi 2-chome, Chiyoda-ku, Tokyo 100-8310, Japan.

II. RELATED APPEALS AND INTERFERENCES

Appellant, appellants' legal representative, and the assignee are not aware of any other prior and pending appeals, interferences, or judicial proceedings that may be related to, directly effect or be directly effected by, or have a bearing on the board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 2-19 are pending in this application. Claim 1 was canceled.

Each of claims 2-19 stands rejected and the rejection of each of claims 2-19 is being appealed.

IV. STATUS OF AMENDMENTS

No amendment was filed subsequent to the Rejection of March 18, 2008.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 2, with reference to Figure 1 in the present specification as a non-limiting example, is directed to a digital content billing system using a network 2 (see also the specification at page 21, lines 1-3). A holder 3a, 3b is configured to have digital content, which is set to become usable by an execution key, and that holds a right to let a user 1a, 1b use the digital content (see also the specification at page 21, lines 10-15). A distributed server 4a, 4b obtains the digital content from the holder 3a, 3b and distributes the digital content to a user 1a, 1b (see also the specification at page 21, lines 12-14). An advertiser 5a, 5b is configured to possess an advertising information piece to be provided for the user 1a, 1b (see also the specification at page 21, lines 22-24).

Further, an administrator server 6a, 6b obtains the execution key from the holder 3a, 3b, obtains the advertising information piece from the advertiser 5a, 5b, receives an execution declaration of the digital content from the user 1a, 1b, downloads the advertising information piece and the execution key to the user 1a, 1b through the network 2, collects an advertising rate from the advertiser 5a, 5b that corresponds to the number of execution times of the digital content used by the user 1a, 1b, and pays an execution fee to the holder 3a, 3b that

corresponds to the number of execution times of digital content (see also the specification at page 21, line 26 to page 22, line 10).

Independent claim 17 recites similar features as in independent claim 2 noted above, but recites that the holder receives the advertising information piece from the advertiser, and that the advertising piece is provided from the holder to the distributor server (see the specification at page 32, lines 27-30 and page 33, line 26 to page 34, line 1).

Independent claim 19 recites similar features as in independent claim 2 noted above, although independent claim 19 recites a combination administrator server and distributor server, as shown for example as element 8a in Figure 34 in the present specification.

The digital content billing system as recited in the claims allows a user to execute desired digital content without payment. That is, as illustrated in a non-limiting embodiment in Figures 6-9, in the claimed system an administrator server bills an advertiser for advertisements seen by a user (see step ST32), collects payments of an advertisement rate corresponding to the advertisement seen by the user (see step ST33), and pays an execution fee to the holder for the digital content downloaded to the user (see step ST34).

Thereby, since the users are not paying for the digital contents, the holder's distribution of digital contents can increase. Further, the holder receives payments for the digital content from the administrator server that simply collects an advertisement rate from an advertiser instead of collecting an execution fee from each user, which may be difficult, time consuming, and resource consuming. Therefore, the claimed digital content billing system can simplify the billing for digital content, can increase reliability in the collection of fees, and can increase the distribution of digital content.

VI. GROUND OF REJECTION

Claims 2, 5-8, and 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. patent application publication 2004/0073451 A1 to Maari in view of International Application No. PCT/JP00/01903 to Nagano, which during a telephone conversation with the Examiner's representative Examiner Shrestha indicated was equivalent to EP 1 209 571 A1 (herein "Nagano").

Claims 3-4, 9-11, and 14-16 were rejected under 35 U.S.C. § 103(a) as unpatentable over Maari in view of Nagano and further in view of U.S. patent 5,740,549 to Reilly et al. (herein "Reilly").

Claim 12 was rejected under 35 U.S.C. § 103(a) as unpatentable over Reilly in view of Nagano and further in view of U.S. patent application publication 2001/0041053 A1 to Abecassis.

Claim 13 was rejected under 35 U.S.C. § 103(a) as unpatentable over Maari in view of Nagano and further in view of U.S. patent 5,948,061 to Merriman et al. (herein "Merriman").

Each of the above-noted rejections is being appealed.

VII. ARGUMENT

Applicants respectfully submit the claims as written clearly recite features neither taught nor suggested by the applied art.

Independent claim 2 positively recites:

an administrator server obtaining the execution key from the holder, obtain the advertising information piece from the advertiser, receiving an execution declaration of the digital content from the user, downloading the advertising information piece and the execution key to the user through the network, ***collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user***, and paying an execution fee to the

holder that corresponds to the number of execution times of the digital content. [Emphasis added].

Independent claim 17 positively recites:

an administrator server obtaining the execution key from the holder, receiving an execution declaration of the digital content from the user, downloading the execution key to the user through the network, and notifying the advertiser of the number of execution times of the digital content used by the user, wherein the holder *collects an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user*, and the holder pays a download charge to the administrator server that corresponds to the number of download times of the execution key downloaded from the administrator server to the user. [Emphasis added].

Independent claim 19 positively recites:

an administrator server and distributor server obtaining the digital content and the execution key from the holder, receiving the advertising information piece from the advertiser, receiving an execution declaration of the digital content from the user, downloading the digital content, the execution key and the advertising information piece to the user through the network in response to the execution declaration, *collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user*, and paying an execution fee to the holder that corresponds to the number of execution times of the digital content used by the user. [Emphasis added].

Applicants respectfully submit the above-noted features clearly distinguish over the applied art. More specifically, applicants respectfully submit none of the cited art discloses or suggests collecting “an advertising rate from the advertiser that corresponds to the number of *execution times of the digital content used by the user*” (emphasis added), as positively recited in each of independent claims 2, 17, and 19.

In the claimed invention an advertiser is billed for the amount of times a user executes a desired digital content. None of the applied art discloses or suggests such a feature, and the outstanding rejection is misconstruing that feature relative to the applied art, particularly as

the cited art to Nagano only discloses providing a payment based on a number of times that a user accesses an ***advertisement, and not digital content*** to which an advertisement is added.

That is, in the claims as written advertisements are added to digital content that can be provided to a user. In the claimed invention, the number of times the digital content is executed is then counted and an advertiser is billed for those number of times. In the claimed invention, the advertiser is ***not billed based on the number of times an advertisement is clicked on or executed***, but instead is billed based on the number of times ***digital content*** to which advertisement is added is executed.

The outstanding rejection with respect to the above-noted claim features states:

Maari does not teach an advertiser processing an advertising information piece to be provided for the user; obtain the advertising information piece from the advertiser; and collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user.

Nagano teaches an advertiser possessing an advertising information piece to be provided for the user; obtain the advertising information piece from the advertiser (Nagano, Fig. 1, Advertising Data Input Device (10) and Advertising Data Database (14) Paragraph [0019], [0023], and [0024]); and collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user (see Fig. 1, Advertising-Fee Calculation/Notification Device (20); Fig. 3, steps S12; paragraph [0026]).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include an advertiser possessing an advertising information piece to be provided for the user; obtain the advertising information piece from the advertiser; and collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user of Maari because Nagano teaches that incorporating above features would enable to determine whether a user actually accesses supplied advertising data accommodating advertisement sponsors (or advertiser) who wish to provide advertising data under a limited budget (Nagano, paragraph [0007]).¹

¹ Office Action of March 18, 2008 pages 4-5 (original emphasis).

The above-noted grounds for rejection is *factually incorrect* in that Nagano does *not* disclose or suggest collecting an advertising rate from an advertiser that corresponds to a number of execution times of digital content. Instead, Nagano discloses collecting an advertising rate from an advertiser *corresponding to a number of times of clicking on an advertisement*. Applicants submit paragraph [0026] of Nagano is clear in that respect. That paragraph in Nagano states:

[0026] The system 10 is also provided with (1) an advertising-data identification/counting device 19, for identifying each advertisement displayed on the display device 18 in response to mouse clicks by the user and *for counting the number of times each advertisement is clicked* (in other words the number of times the data is displayed), and (2) an advertising-fee collection/notification device 20, for *calculating advertising fees based on the number of times each advertisement is clicked*, as counted by the advertising-data identification/counting device 19, and for notifying the corresponding sponsors of the advertising feed periodically or with each access request. [Emphasis added].

From the above-noted disclosure it is clear that in Nagano the counting for determining advertisement fees is based on the number of times each advertisement is clicked, and is *not* based on the number of times content to which advertising is added is executed.

In the claimed invention, advertising is added to digital contents, but an advertising rate is calculated based on the number of times the digital content is executed. In the claimed invention an advertisement rate is *not* collected based on the number of times an advertisement is clicked on.

In such ways, Nagano does not disclose or suggest the features reflected in the claims, and no combination of teachings of Maari and Nagano meets the above-noted claim features of “collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user”, as positively recited in each of independent claims 2, 17, and 19.

Moreover, no disclosures in any of the further cited art to Reilly, Abecassis, or Merriman were cited with respect to the above-noted features, and no disclosures in any of the further cited Reilly, Abecassis, or Merriman are believed to cure the above-noted deficiencies of Maari in view of Nagano.

CONCLUSION

In view of these foregoing comments, applicants respectfully submit the claims as currently written clearly distinguish over the applied art, and thereby the outstanding rejections must be REVERSED.

Respectfully submitted,

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CLAIMS APPENDIX

Claim 1 (Canceled).

Claim 2 (Previously Presented): A digital content billing system using a network, comprising:

a holder having digital content, which is set to become usable by an execution key, and holding a right to let a user use the digital content;

a distributor server obtaining the digital content from the holder and distributing the digital content to a user;

an advertiser possessing an advertising information piece to be provided for the user; and

an administrator server obtaining the execution key from the holder, obtain the advertising information piece from the advertiser, receiving an execution declaration of the digital content from the user, downloading the advertising information piece and the execution key to the user through the network, collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user, and paying an execution fee to the holder that corresponds to the number of execution times of the digital content.

Claim 3 (Original): A digital content billing system using a network according to claim 2, wherein the advertising information piece downloaded to the user is displayed simultaneously with the digital content in cases where the user uses the digital content by using the execution key downloaded to the user.

Claim 4 (Previously Presented): A digital content billing system using a network according to claim 2, wherein the advertising information piece downloaded to the user is displayed in a time period between time periods in which the digital content is displayed in cases where the user uses the digital content by using the execution key downloaded to the user.

Claim 5 (Previously Presented): A digital content billing system using a network according to claim 2, wherein the distributor server notifies the holder of the number of download times of the digital content downloaded to the user, and the holder pays to the distributor server a download charge that corresponds to the number of download times of the digital content.

Claim 6 (Previously Presented): A digital content billing system using a network according to claim 2, wherein, when the administrator server receives the execution declaration from the user, the administrator server downloads to the user a plurality of advertising information pieces and the execution key, which permits the user to use the digital content a prescribed number of times.

Claim 7 (Previously Presented): A digital content billing system using a network according to claim 2, wherein, when the execution key is not currently downloaded to the user from the administrator server because of an abnormal state even though a prescribed time has passed after the user sent the execution declaration of the digital content, the user uses the digital content by using an execution key downloaded from the administrator server in the past while seeing an advertising information piece downloaded from the administrator server in the past.

Claim 8 (Previously Presented): A digital content billing system using a network according to claim 7, wherein after the abnormal state has passed the user notifies the administrator server that the user used the digital content by using the execution key downloaded from the administrator server in the past.

Claim 9 (Previously Presented): A digital content billing system using a network according to claim 2, wherein the advertising information piece downloaded from the administrator server to the user corresponds to content of the digital content.

Claim 10 (Previously Presented): A digital content billing system using a network according to claim 2, wherein, when the administrator server receives the execution declaration of the digital content from the user, the administrator server requires the user to select a genre of the advertising information piece to be downloaded to the user, and the advertising information piece of the selected genre is downloaded to the user.

Claim 11 (Previously Presented): A digital content billing system using a network according to claim 2, wherein, when the administrator server receives the execution of declaration of the digital content from the user, the administrator server downloads to the user the advertising information piece that corresponds to content of another digital content used by the user in the past.

Claim 12 (Previously Presented): A digital content billing system using a network according to claim 2, wherein the administrator server collects the advertisement rate from the advertiser that is determined according to a matching point between content of the digital

content related to the execution declaration of the user and content of the advertising information piece downloaded from the administrator server to the user.

Claim 13 (Previously Presented): A digital content billing system using a network according to claim 2, wherein the administrator server guarantees the advertiser a minimum number of downloading times the advertising information piece is downloaded to the user or a minimum ratio of the number of downloading times the advertising information piece is downloaded to the user to the number of downloading times of all advertising information pieces downloaded to the user.

Claim 14 (Previously Presented): A digital content billing system using a network according to claim 2, wherein, when the administrator server receives the execution declaration of the digital content from the user, the administrator server requires the user to select a residential district of the user and the administrator server downloads to the user the digital content that closely relates to the residential district of the user.

Claim 15 (Previously Presented): A digital content billing system using a network according to claim 2, wherein, when the administrator server receives the execution declaration of the digital content from the user, the administrator server downloads the digital content that closely relates to a residential district of the user and a nationwide digital content to the user.

Claim 16 (Previously Presented): A digital content billing system using a network according to claim 2, wherein, when the administrator server receives the execution declaration of the digital content from the user, the administrator server downloads to the user

the digital content closely related to a residential district of the user, which is obtained from a network operator managing the network.

Claim 17 (Previously Presented): A digital content billing system using a network, comprising:

an advertiser possessing an advertising information piece to be provided for a user;

a holder receiving the advertising information piece from the advertiser, having digital content that is set to become usable by an execution key, and holding a right to let a user use the digital content;

a distributor server obtaining from the holder the digital content that includes the advertising information piece and distributing the digital content with the advertising information piece to the user; and

an administrator server obtaining the execution key from the holder, receiving an execution declaration of the digital content from the user, downloading the execution key to the user through the network, and notifying the advertiser of the number of execution times of the digital content used by the user, wherein the holder collects an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user, and the holder pays a download charge to the administrator server that corresponds to the number of download times of the execution key downloaded from the administrator server to the user.

Claim 18 (Previously Presented): A digital content billing system using a network according to claim 17, wherein the distributor server notifies the holder of the number of download times of the digital content downloaded to the user, and the holder pays a

download charge to the distributor server that corresponds to the number of download times of the digital content.

Claim 19 (Previously Presented): A digital content billing system using a network, comprising:

a holder having digital content, which is set to become usable by an execution key, and holding a right to let a user use the digital content;

an advertiser possessing an advertising information piece to be provided for a user; and

an administrator server and distributor server obtaining the digital content and the execution key from the holder, receiving the advertising information piece from the advertiser, receiving an execution declaration of the digital content from the user, downloading the digital content, the execution key and the advertising information piece to the user through the network in response to the execution declaration, collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user, and paying an execution fee to the holder that corresponds to the number of execution times of the digital content used by the user.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.